

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P. O. Box 272400  
Fort Collins, Colorado 80527-2400

## PATENT APPLICATION

ATTORNEY DOCKET NO. 10006504-1

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Quintin T. Phillips et al.

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Confirmation No.: 6319

Application No.: 09/932,638

Examiner: Yogesh Garg

Filing Date: 8/16/2001

NOV 23 2005

Group Art Unit: 3625

Title: Image Forming Devices and Marketing Methods

## Mail Stop

Commissioner For Patents

PO Box 1450

Alexandria, VA 22313-1450

## TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- ( ) Response/Amendment ( ) Petition to extend time to respond  
( ) New fee as calculated below ( ) Supplemental Declaration  
( ) No additional fee  
(X) Other: Notice of Allowance; Pre-Appeal Brief; Pre-Appeal Brief Request For Review  
Interview Summary

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$200	\$ 0
[ ] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$360	\$ 0
EXTENSION FEE	1ST MONTH \$120.00	2ND MONTH \$450.00	3RD MONTH \$1020.00	4TH MONTH \$1590.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

(X) I hereby certify that this paper is being transmitted  
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Number of pages: 11

Typed Name: Natalie King

Signature:

Quintin T. Phillips et al.

By

James D. Shaurette

Attorney/Agent for Applicant(s)

Reg. No. 39,833

Date: 11/23/05

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- Attach as First Page to Transmitted Papers -

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Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 10006504-1 (HE12-175)	
I hereby certify that this correspondence is being transmitted to the U.S. PTO via facsimile to 571-273-8300 to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 [37 CFR 1.8(a)] on <u>November 23, 2005</u>		Application Number 09/932,638	Filed 08/16/2001
Signature 		First Named Inventor Quintin T. Phillips et al.	
Typed or printed name Natalie King		Art Unit 3625	Examiner Yogesh C. Garg
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). (See Pre-Appeal Brief A) Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		James D. Shaurette Typed or printed name	
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>39,833</u>		(509) 624-4276 Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u>11/23/05</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Date of Deposit: 11/23/2005

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Signature: PATENT APPLICATION  
DOCKET NO. 10006504-1IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Quintin T. Phillips

SERIAL NO.: 09/932,638

GROUP ART UNIT: 3625

FILED: August 16, 2001

EXAMINER: Y. Garg

SUBJECT: Image Forming Devices and Marketing Methods

PRE-APPEAL BRIEF A

Concurrent with the filing of a Notice of Appeal in connection with the above-identified application, the undersigned requests review of the Final Office Action dated August 24, 2005 (hereinafter "the Office Action") of the following issues.

Appellants thank Examiner Garg for the courtesies extended to the undersigned during the telephone interview. The Examiner indicated that the 112, first paragraph rejection and the objection to the specification of the Office Action are withdrawn in view of the teachings of paragraphs 0019, 0020 and 0051 of the originally filed specification.

Limitations of the independent claims are not disclosed nor suggested by Sekizawa and the anticipation rejection is improper.

The independent claims 9 and 17 recite *communicating a request externally of the image forming device using the image forming device, and the image forming device is configured to use a consumable to form a hard image* which limitations are

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absent from Sekizawa. The Office on page 7 of the Office Action recites teachings in cols. 18-19 as allegedly disclosing limitations of claim 1. At page 3, the Office states the agent unit communicates a request to console unit 20 which receives the message. However, *the communications of the agent unit may not be fairly considered to disclose or suggest the communicating the request using an image forming device which is configured to use a consumable to form a hard image*. Fig. 1 of Sekizawa clearly discloses printers P distinguished from agent unit 10. Agent unit 10 does not use a consumable as recited in the claims and agent unit 10 is not disclosed as being configured to form a hard image upon media such as paper as defined in paragraph 20 of the specification. The claimed communicating the request using the image forming device is not disclosed nor suggested by the prior art and the claims are allowable for at least this reason.

At col. 19, lines 20+, it is stated that agent unit 10 gets status information  $\phi$  1 and prepares status mail  $\phi$  2 storing the status information  $\phi$  1 and which is sent to mail server 19. Neither of the status information  $\phi$  1 nor status mail  $\phi$  2 are disclosed as comprising a request. *In no fair interpretation may the status information communicated by the printers P or the status mail  $\phi$  2 of Sekizawa be considered to disclose or suggest the communication of a request. Further, the communication of  $\phi$  2 is performed by the agent unit 10 which may not be fairly considered to disclose or suggest the claimed communicating the request using the image forming device.*

Independent claim 9 also recites receiving a message responsive to the communicating the request and communicating the message using the image forming device. Independent claim 17 recites communicating a message responsive to a request and communicating the message using the image forming device. The teachings in cols. 18-19 of Sekizawa fail to disclose or suggest communication of a message responsive to a request, receiving a message responsive to the communication of the request or communication of the message using the image forming device. The status information  $\phi$  1 communicated by the printers of Sekizawa does not disclose or suggest the claimed receiving a message of claim 9 or communicating the message received responsive to the communicating the request of claim 17. Further, the claimed communicating the message using the

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image forming device of claims 9 and 17 is not disclosed nor suggested by Sekizawa and the claims are allowable for this additional reason.

The Office responded to Appellants' arguments of the Response mailed May 4, 2005 in the Office Action relying upon teachings in cols. 5-9 of Sekizawa. Appellants requested clarification of the teachings relied upon with reference to the figures of Sekizawa as opposed to reliance by the Office upon the Summary of Invention including generic teachings in cols. 5-9 which describe numerous generic embodiments in claim language as opposed to the detailed description of Sekizawa. No clarification has been provided but the teachings of Sekizawa fail to disclose or suggest limitations of the claims for at least the above-mentioned compelling reasons.

**Limitations of claims 10 and 18 are not disclosed nor suggested by Sekizawa and the anticipation rejection is improper.**

Referring to dependent claims 10 and 18, the methods recite *accessing the condition from the consumable*. The teachings at lines 21-35 of col. 19 relied upon by the Office fail to disclose or suggest the claimed *accessing of anything from a consumable let alone the specifically claimed accessing of the condition associated with an operation of the image forming device from the consumable*. The identified teachings of col. 19 merely state that agent unit 10 gets status information from the printer and which includes information regarding a status of a consumable. The identified teachings do not teach or suggest *accessing a condition associated with an operation of the image forming device from the consumable* as claimed. Further, the teachings of cols. 16-17 relied upon by the Office again refer to generic embodiments of the Summary and fail to cure the deficiencies of the teachings in col. 19 or other teachings of the detailed description of Sekizawa. Limitations of the claims are not disclosed nor suggested and the claims are allowable.

**Limitations of claims 16 and 23 are not disclosed nor suggested by Sekizawa and the anticipation rejection is improper.**

The methods recite *communicating the request including an identifier of the image forming device using the image forming device*. The Office relies upon teachings of Fig. 17 and cols. 20-21 as allegedly disclosing the limitations of claim

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16. However, Fig. 17 refers to a *printer registration log file which is retained within the agent unit 10* (col. 17, lines 51-55, col. 19, line 45 - col. 20, line 1), and Appellants have been unable to locate any teachings of a request communicated by the printer P of Sekizawa including an identifier of the printer. The operations of the agent unit external of the printers P of Sekizawa fail to teach or suggest *communicating the request including the identifier using the image forming device* as claimed. Claims 16 and 23 are allowable for this additional reason.

**Additional limitations of claim 23 are not disclosed nor suggested by Sekizawa and the anticipation rejection is improper.**

The Office relies upon the teachings of col. 19, lines 15-35 as allegedly disclosing the claimed *selecting the message from a plurality of other messages using the identifier of the image forming device and communicating the message after the selecting*. The teachings of col. 19, lines 15-35 relied upon by the Office merely refer to a console unit reading a large number of pieces of mail and that the console unit may send a delivery schedule or a printer check sheet. The teachings fail to disclose or suggest the claimed *selecting the message from a plurality of other messages using the identifier* of the image forming device as specifically defined in claim 23. The teachings of col. 35 relied upon by the Office refer to change mail  $\phi$  4 which have not been demonstrated to comprise a request communicated by a printer of Sekizawa or that the message is selected using the identifier as positively claimed. Claim 23 is allowable for this additional reason.

**There is no motivation to combine the teachings of Hayward with the teachings of Sekizawa and the rejection of claims 25-26 and 30 is improper.**

MPEP 2143.01 (8<sup>th</sup> ed., rev. 2) and the Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The Court in *In re Lee* stated the factual inquiry whether to combine references must be *thorough and searching*, based *on objective evidence of record, deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense and specific factual findings are needed*. Despite the Federal Circuit and MPEP authority, the Office has failed to present any evidence that the comprehensive system of Sekizawa suffers from increased downtime or that any

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improvements to the disclosure of Sekizawa would result from the modification compared to the teachings of Sekizawa taken by itself to motivate one to combine the reference teachings. There is no motivation to combine the reference teachings and the Office has failed to establish a proper prima facie rejection.

**The reliance upon Official Notice is improper and the rejection of claim 27 is improper.**

The Office on page 13 relies upon Official Notice in support of the rejection. The undersigned hereby traverses any reliance upon Official Notice pursuant to MPEP 52144.03 (8<sup>th</sup> ed., rev. 2). MPEP 2144.03A (8<sup>th</sup> ed., rev. 2) provides that *official notice unsupported by documentary evidence should only be taken by the examiner when the facts asserted to be well known or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known.* Appellant respectfully submits claims are analyzed in the context of the combination of the various separately stated limitations, and not with respect to the limitations individually. There is absolutely no evidence of record of the claimed printing of a message upon paper where the message was received responsive to a request which was communicated externally of the image forming device responsive to monitoring of an operation of the image forming device. Claim 27 is allowable for the above-mentioned reason.

#### Conclusion

Appellants respectfully request reconsideration of at least the above-identified claim rejections and allowance of the respective claims for at least the above-identified reasons.

Respectfully submitted,

Quintin T. Phillips

By: 

James D. Shaurette

Reg. No. 39,833

Date: 11/23/05

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PDNO. 10006504-1  
Pre-Appeal Brief A

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Date of Deposit: 11/23/05

Typed Name of Person Mailing Paper or Fee: Natalie King

Signature: PATENT APPLICATION  
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INVENTOR(S): Quintin T. Phillips

SERIAL NO.: 09/932,638

GROUP ART UNIT: 3625

FILED: August 16, 2001

EXAMINER: Y. Garg

SUBJECT: Image Forming Devices and Marketing Methods

MAIL STOP APPEALS - PATENTS  
ASSISTANT COMMISSIONER FOR PATENTS  
P.O. BOX 1450  
WASHINGTON, D.C. 20231Interview Summary A

SIR:

Appellants wish to thank the Examiner for the courtesies extended to the undersigned during the telephone interview. Appellants and the Examiner discussed the objection to the specification and the 112, first paragraph rejection and the Examiner indicated that the objection and 112 rejection would be withdrawn. Appellants and the Examiner discussed the rejections of claims 9, 10, 16, 23, 25, 26 and 27. No agreement was reached regarding the patentability of any pending claim. Details regarding the specific discussions of the claims are set forth in the Response filed May 5, 2005 and the Pre-Appeal Brief which accompanies the Notice of Appeal filed herewith.

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The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Quintin T. Phillips

By:

  
James D. Shaurette

Reg. No. 39,833

Date:

11/23/05

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Interview Summary A